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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,652

09/07/2006

Oliver Schaefer

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22045 7590 05/29/2009

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,652	Applicant(s) SCHAEFER ET AL.	
	Examiner MARC S. ZIMMER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schäfer et al., U.S. Patent # 6,534,615.

Applicants first assert that their discovery that the elimination of a need for the same hold times that were required to evaluate the product mixture of the prior art batch process was surprising. The Examiner is unclear as to why this realization hadn't been expected. In-process sampling allows the practitioner the opportunity to gauge the outcome of the process in real time and make the necessary adjustments, usually in the flow rates of the reactants into the reactor. This is a benefit of a continuous process known to any process chemist having ordinary skill.

As for the Examiner's citation of *In re Dilnot*, Applicants correctly note that the court indicated that claim 22, the claim in dispute, was not, in fact, drawn to a continuous process but, instead, a batch process having as one of its steps the continuous incorporation of a foam and, in this sense, was not patentably distinguishable from the prior art of record (Jahjah). On the other hand, it is stated in that decision that, even had Appellant's claim actually been directed to a continuous process, there were several earlier decisions in which it was concluded that one of

Art Unit: 1796

ordinary skill would be expected to be capable of carrying out the operation of a process in a continuous fashion. See the third-to-last paragraph of the case summary.

Applicant then notes that, whereas some batch processes are easily conducive to the development of a continuous process, attempts to convert others into a continuous process have failed even after years of experimentation. They go on to emphasize that often an undue amount of experimentation is required which the Examiner infers from other remarks is correlated with the level of unpredictability associated with the process. The Examiner appreciates that a process where outcomes are difficult to control may indeed require a considerable amount of investigation. However, it is not clear what new uncertainties are introduced that must be addressed when one attempts to translate the known batch process of the prior art into a continuous process. Moreover, some chemical reactions are substantially more unpredictable than are others and the record does not reflect that the reaction of a silanol-bearing silicone with a sil(ox)azane is especially unpredictable. The Examiner earlier established that there appear to be no special apparatus design considerations or other indicators that would lend to the belief that there were significant obstacles to development of a continuous process alternative to the known batch process.

Finally, in a footnote, the observation is made that the present invention was made four years after patent for the batch process was originally filed and that this should be regarded as evidence of the non-obviousness of the invention. The Examiner respectfully disagrees. There could be any number of reasons why four years elapsed between the time that the batch and continuous processes were invention. Also, the

Art Unit: 1796

Examiner has no way of knowing whether or not the beginning of the effort to develop the continuous process immediately followed the perfection of the batch process or even if the effort had been a sustained one.

Terminal Disclaimer

The terminal disclaimer filed on March 10 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent # 6,534,615 has been reviewed and is accepted. The terminal disclaimer has been recorded.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1796

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 27, 2009

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796